



JAN 19 2006 Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx  
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

## PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

2500 DIV2 CON2 DIV3 CON7  
203-3515 DIV2 CON2 DIV3 CON7

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on January 17, 2006Signature Dana A BrusselTyped or printed name Dana A. Brussel

Application Number

10/743,192

Filed

December 22, 2003

First Named Inventor

Peter M. Bonutti

Art Unit

3731

Examiner

Michael H. Thaler

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

 applicant/inventor. assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96) attorney or agent of record.  
Registration number \_\_\_\_\_ attorney or agent acting under 37 CFR 1.34.Registration number if acting under 37 CFR 1.34 45,717Dana A Brussel  
Signature

Dana A. Brussel

Typed or printed name

(631) 501-5700

Telephone number

January 17, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.  
Submit multiple forms if more than one signature is required, see below\*.

 \*Total of \_\_\_\_\_ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Appl. No. 10/743,192  
Communication dated January 17, 2006



Atty. Docket: 2500 DIV2 CON2 DIV3 CON7  
(203-3515 DIV2 CON2 DIV3 CON7)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**APPLICANT:** Peter M. Bonutti

**EXAMINER:** Thaler, Michael H.

**SERIAL NO.:** 10/743,192

**GROUP UNIT:** 3731

**FILED:** December 22, 2003

**DATED:** January 17, 2006

**FOR: FLUID OPERATED RETRACTORS**

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**REMARKS IN SUPPORT OF**  
**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Sir:

The above-referenced application has been reviewed in light of the Advisory Action mailed January 13, 2006 and the final Office Action mailed July 15, 2005. By the present communication, the Applicant respectfully requests a panel review of the final rejection in the above-identified application. A Notice of Appeal is being filed concurrently with this request.

The Advisory Action maintained the rejection of claims 1-4 and 7. In the Office Action mailed on July 15, 2005, these claims were rejected under 35 U.S.C. § 102 (b) as being anticipated by, or in the alternative, under 35 U.S.C. § 103 (a) as obvious over U.S. Patent No. 3,417,745 to Sheldon (the '745 patent).

---

**CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8(a)**

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postpaid in an envelope, addressed to: Mail Stop AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on January 17, 2006.

Dated: January 17, 2006

  
Dana A. Brussel

However, the '745 patent, either explicitly or impliedly, fails to disclose every aspect of the claimed apparatus as required under 35 U.S.C. § 102. In addition, the '745 patent does not suggest modifying the disclosed device and yielding the claimed apparatus as required under 35 U.S.C. § 103. Therefore, the Office Action fails to establish its *prima facie* case for an anticipation rejection under 35 U.S.C. § 102 (b) and for obviousness under 35 U.S.C. § 103.

The '745 patent explicitly discloses a device for viewing regions of a patient's spinal column. According to the '745 patent, the device includes an inflatable member attached to a distal end of the device, wherein the inflatable member is inflated to move the dural sac in the patient's spinal column, thereby providing a clear field of sight to a herniated disc that is hidden by the dural sac. In particular, the '745 patent discloses that "[i]n some cases it was found necessary to provide an adequate space between the optical viewing system such as 19, or 19c, and the examined part."<sup>1</sup> Additionally, the '745 patent continues and states that "[t]he inflation of the member 57 causes separation of the examined part from the distal end of the spinescope."<sup>2</sup> The '745 patent discloses several embodiments of the spinescope, each of which is suitable for insertion into a patient's spinal column and displacing soft tissue (i.e. the dural sac) or turbid fluid which obstructs the view of the herniated disc (i.e. the examined part).<sup>3</sup> In particular, the '745 patent specifically discloses that:

[i]t was found that in many examinations the spinal fluid was turbid and impaired is [sic] visibility. I have solved this problem by the construction in which an inflatable transparent member is mounted at the distal end of the spinescope. The inflated member 50 displaces the turbid spinal fluid and produces thereby a clear field of vision.<sup>4</sup>

---

<sup>1</sup> U.S. Patent No. 3,417,745 at Column 8, line 74 - Column 9, line 23.

<sup>2</sup> *Ibid.*

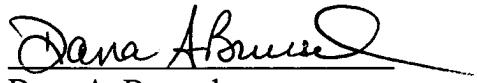
<sup>3</sup> See Applicant's amendment response of December 12, 2005 on page 6.

<sup>4</sup> *Ibid* at Column 8, lines 49-54.

Clearly, the '745 patent teaches a device that is adapted for urging soft tissue away from the distal end of the device, thereby providing an unobstructed field of view through the instrument. In doing so, the '745 patent teaches away from an apparatus that separates adjacent portions of bone tissue, such as the apparatus recited in claim 1 of the instant application. Ergo, the '745 patent does not teach or fairly suggest an apparatus having an inflatable member arranged to separate adjacent portions of bone tissue.

Therefore, the '745 patent does not anticipate the claimed apparatus since it fails explicitly or inherently disclose every feature recited in claim 1 as required under 35 U.S.C. § 102. Furthermore, the '745 does not suggest to one of ordinary skill in the art that the device disclosed therein should be modified such that the inflatable bladder separates adjacent portions of bone tissue as recited in claim 1 as required under 35 U.S.C. § 103.

Respectfully submitted,

  
Dana A. Brussel  
Reg. No. 45,717  
Attorney for Applicant

Carter, DeLuca, Farrell & Schmidt, LLP  
445 Broad Hollow Road - Suite 225  
Melville, New York 11747  
Tel.: (631) 501-5713  
Fax: (631) 501-3526

**Send correspondence to:**  
Chief Patent Counsel  
Tyco Healthcare Group  
195 McDermott Road  
North Haven, CT 06473